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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,744	05/18/2006	Daria Onichtchouk	2923-753	9418

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EXAMINER	
DANG, IAN D	

ART UNIT	PAPER NUMBER
1647	

NOTIFICATION DATE	DELIVERY MODE
07/24/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No.	Applicant(s)	
	10/579,744	ONICHTCHOUK, DARIA	
	Examiner	Art Unit	
	IAN DANG	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-43* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application, Amendments, and/or Claims

The previous restriction requirement (mailed on 6/27/2008) was in error as it included a species election. Therefore, the previous restriction requirement (mailed on 6/27/2008) has been vacated accordingly. This current restriction requirement is replacing the one mailed on 6/27/2008.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1-8, claim(s) 1-2, 9-10, 14-21, 41 drawn to a pharmaceutical composition comprising a SF1-SF8 protein and/or functional fragment.

Group 9-16, claim(s) 1-8, 11-21, 27, 28, 41 drawn to a pharmaceutical composition comprising a SF1-SF8 nucleic acid molecule encoding a SF-1-SF8 protein.

Group 23-30, claim(s) 1-2, 9-10, 14-21, drawn to a pharmaceutical composition comprising an effector/modulator of an SF1-SF8 protein.

Group 31-38, claim(s) 1-8, 11-21 drawn to a pharmaceutical composition comprising an effector/modulator to an SF-1-SF8 nucleic acid.

Group 39-46, claim(s) 22-23, 35, 37, 38, drawn to the use of a SF1-SF8 nucleic acid molecule for the manufacture of a medicament.

Group 47-54, claim(s) 22-23, 36, 38 drawn to the use of a SF1-SF8 polypeptide encoded thereby or a fragment or a variant for the manufacture of a medicament.

Group 55-62, claim(s) 22-23, drawn to the use of an effector/modulator of a SF1-SF8 nucleic acid for the manufacture of a medicament.

Group 63-70, claim(s) 22-23, drawn to the use of an effector/modulator of a SF1-SF8 polypeptide for the manufacture of a medicament.

Group 71-78, claim(s) 24, drawn to the use of a SF1-SF8 nucleic acid molecule for identifying substances capable of interacting with a SF1-SF8 polypeptide.

Group 79-86, claim(s) 24, use of a SF1-SF8 polypeptide encoded thereby or a fragment or a variant for identifying substances capable of interacting with a SF1-SF8 polypeptide.

Group 87-94, claim(s) 24, drawn to the use of an effector/modulator of a SF1-SF8 nucleic acid for identifying substances capable of interacting with a SF1-SF8 polypeptide.

Group 95-102, claim(s) 24, drawn to drawn to the use of an effector/modulator of a SF1-SF8 polypeptide for identifying substances capable of interacting with a SF1-SF8 polypeptide.

Group 103-110, claim(s) 25-26, drawn to a non-human transgenic animal exhibiting an increased expression of a SF1-SF8 polypeptide.

Group 111-118, claim(s) 25-26, drawn to a non-human transgenic animal exhibiting a reduced expression of a SF1-SF8 polypeptide.

Group 119-126, claim(s) 29, drawn to a method of identifying a polypeptide involved in the regulation of energy homeostasis and/or metabolism in a mammal comprising the steps of a SF1-SF8 polypeptide.

Group 127-134, claim(s) 30, drawn to a method of screening for an agent which effects/modulates the interaction or a SF1-SF8 polypeptide with a binding target.

Group 135-142, claim(s) 31, drawn to a method of screening for an agent which effects/modulates the interaction or a SF1-SF8 polypeptide.

Group 143-150, claim(s) 32-33, drawn to a method of producing a composition comprising mixing a polypeptide that is involved with the regulation of energy homeostasis and/or metabolism in a mammal comprising contacting a SF1-SF8 polypeptide.

Group 151-158 claim(s) 34 and 39, drawn to the use of a polypeptide as identified by the method of identifying a polypeptide involved in the regulation of energy homeostasis and/or metabolism in a mammal comprising the steps of contacting a polypeptide SF1-SF8.

Group 159-166, claim(s) 40, drawn to the use of a SF1-SF8 nucleic acid molecule or a fragment for the production of a non-human transgenic animal that overexpresses the SF1-F8 gene product.

Group 167-174, claim(s) 40, drawn to the use of a SF1-SF8 nucleic acid molecule or a fragment for the production of a non-human transgenic animal that underexpresses the SF1-F8 gene product.

Group 175-182, claim(s) 42, drawn to a method of producing a composition mixing the agent identified by the method of screening for an agent which effects/modulates the interaction or a SF1-SF8 polypeptide with a binding target.

Group 183-190, claim(s) 43, drawn to the use of an agent identified by the method of screening for an agent which effects/modulates the interaction of a SF1-SF8 polypeptide with a binding target.

The inventions listed as Groups 1-190 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups 1-190 do not relate to a single general inventive concept because they lack the same or corresponding technical feature.

Claim 1 is directed to a pharmaceutical composition comprising a SF1-SF8 protein or a functional fragment thereof. Li et al teach a SF1 protein expressed in human liver non-tumor tissue that inherently meets the limitations of a pharmaceutical composition (see AAK14915 submitted December 8, 1999). The prior art meets the limitations disclosed in claim 1. Thus Group I lacks novelty or inventive step and does not make a contribution over the prior art. Since the first claimed invention has no special technical feature, it cannot share a special technical feature with the other claimed invention.

Under PCR Rule 13.1, the application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IAN DANG whose telephone number is (571)272-5014. The examiner can normally be reached on Monday-Friday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ian Dang
Patent Examiner
Art Unit 1647
July 17, 2008

/Manjunath N. Rao, /
Supervisory Patent Examiner, Art Unit 1647